



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/586,295 06/02/00 BAKER

M CB-7-2

021394
ARTHROCARE CORPORATION
595 NORTH EASTORIA AVENUE
SUNNYVALE CA 94085-2936

QM12/1024

EXAMINER

MELENDEZ, M

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

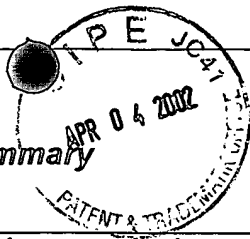
10/24/01

Due: Jan. 24, 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary



Application No.

09/586,295

Applicant(s)

BAKER ET AL

Examiner

Manuel Mendez

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

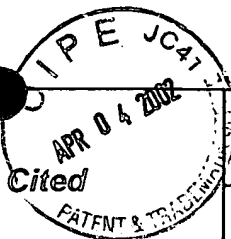
Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Notice of References Cited



Application/Control No.

09/586,295

Applicant(s)/Patent Under
Reexamination
BAKER ET AL.

Examiner

Manuel A Mendez

Art Unit

3763

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
	A	US-6149620	11-2000	Baker, et al.	604	22
	B	US-				
	C	US-				
	D	US-				
	E	US-				
	F	US-				
	G	US-				
	H	US-				
	I	US-				
	J	US-				
	K	US-				
	L	US-				
	M	US-				

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification	
	N						
	O						
	P						
	Q						
	R						
	S						
	T						

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Art Unit: 3763



DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 1-22** of U.S. Patent No. **6149620**. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel Mendez whose telephone number is 703-308-2221. The examiner can normally be reached on 0730-1800 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Seidel can be reached on 703-308-5115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590



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09/457,201 12/06/99 DAVISON

T CB-7-1

021394
ARTHROCARE CORPORATION
595 NORTH PASTORIA AVENUE
SUNNYVALE CA 94085-2936

QM32/0828

EXAMINER

MEÑDEZ, M

ART UNIT

PAPER NUMBER

3763
DATE MAILED:

08/28/01

Due: Nov. 28, 2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

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BAKER ET AL

Examiner

Manuel A Mendez

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Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11-20 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 21-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

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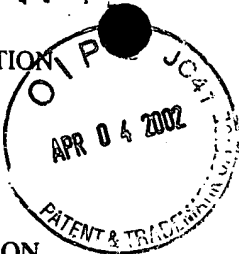
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- a) ☐ All b) ☐ Some * c) ☐ None of:
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- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

ARTHROCARE CORPORATION
595 N. Pastoria Avenue
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(408) 736-0224
Customer No. 21394



Atty. Docket No. CB-7-2

"Express Mail" Label No. EK628671824US

Date of Deposit June 2, 2000

I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231

By: [Signature]

BOX PATENT APPLICATION
ASSISTANT COMMISSIONER FOR PATENTS
Washington, D. C. 20231

Sir:
Transmitted herewith for filing under 37 CFR §1.53(b) is the
[] patent application, [] continuation patent application,
[X] divisional patent application, or [] continuation-in-part patent application of

EK628671824US

Inventor(s)/Applicant Identifier: **MICHAEL A. BAKER, STEPHEN M. BRUNELL, JEAN WOLOSZKO, RONALD A. UNDERWOOD, HIRA V. THAPLIYAL, and PHILIP E. EGGERS**

For: **SYSTEM FOR ELECTROSURGICAL TISSUE TREATMENT IN THE PRESENCE OF ELECTRICALLY CONDUCTIVE FLUID (as amended)**

- [X] This application claims priority from each of the following Application Nos./filing dates:
09/248,763 / February 12, 1999; 60/096,150 / August 11, 1998; 60/098,122 / August 27, 1998;
08/795,686 / February 5, 1997; 08/561,958 / November 22, 1995 the disclosure(s) of which is (are) incorporated by reference.
[X] Please amend this application by adding the following before the first sentence: --This application is a [] continuation [X] division of and claims the benefit of U.S. Application No. 09/248,763 / February 12, 1999 the disclosure of which is incorporated by reference.--

Enclosed are:

- [X] 31 sheet(s) of [] formal [X] informal drawing(s); specification including description, claims and abstract; [X] title page.
[X] A copy of the assignment of the invention to ArthroCare Corporation.
[X] A copy of the [X] signed [] unsigned Declaration and Power of Attorney
[] A verified statement to establish small entity status under 37 CFR 1.9 and 37 CFR 1.27 [] is enclosed [] was filed in the prior application.
[] A certified copy of a _____ application.
[X] Information Disclosure Statement under 37 CFR 1.97.
[] Preliminary Amendment
[X] Please cancel claim(s) 1-10 and 21-32

	(Col. 1)	(Col. 2)
FOR:	NO. FILED	NO. EXTRA
BASIC FEE		
TOTAL CLAIMS	10 -20=	* 0
INDEP CLAIMS	1 -3=	* 0
[] MULTIPLE DEPENDENT CLAIM PRESENTED		

* If the difference in Col. 1 is less than zero, enter "0" in Col. 2

SMALL ENTITY

RATE	FEE
	\$
X9=	\$
X39=	\$
+130=	\$
TOTAL	\$

OR
OR
OR
OR
OR
OR

OTHER THAN A
SMALL ENTITY

RATE	FEE
	\$690
X18=	\$
X78=	\$
+260=	\$
TOTAL	\$690

Please charge Deposit Account No. 50-0359 as follows:

- [X] Filing fee
[X] Any additional fees associated with this paper or during the pendency of this application
[] The issue fee set in 37 CFR 1.18 at or before mailing of the Notice of Allowance, pursuant to 37 CFR 1.311(b).

\$ 690.00

[] A check for \$ _____ is enclosed.
1 extra copies of this sheet are enclosed.

Respectfully submitted,
ARTHROCARE CORPORATION